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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/614,691	07/07/2003	Michael D. Kobrehel	11361.85367	7424
28316	7590	12/27/2004	EXAMINER	
BANNER & WITCOFF LTD., ATTORNEYS FOR DURA AUTOMOTIVE 28 STATE STREET - 28TH FLOOR BOSTON, MA 02109				ESTREMSKY, GARY WAYNE
ART UNIT		PAPER NUMBER		
3676				

DATE MAILED: 12/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/614,691	KOBREHEL, MICHAEL D.	
	Examiner Gary Estremsky	Art Unit 3676	<i>MW</i>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 23-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 28,34-41 and 43 is/are allowed.
- 6) Claim(s) 23-25,30,31 and 33 is/are rejected.
- 7) Claim(s) 26,27,29,32 and 42 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 7/7/03 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Terminal Disclaimer

1. The terminal disclaimer filed on 9/8/04 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of USPN 6,688,659 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 23-25, 30, 31, and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 3,083,419 to Pennington.

Penningtom '419 teaches Applicant's claim limitations including : a "pane" – as shown on the face of the Patent, a "latch bolt housing" – 78, "mounted to the pane" – as shown, a "latch bolt" – including 110, "adapted for compound sliding movement" – explicitly disclosed for a combination of linear and rotary sliding motion "in a plane substantially parallel to the plane of the pane" a "biasing member" – 98, a "release handle" – end portions 114.

As regards the 'compound sliding movement' limitation, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. In order to expedite prosecution as much as possible, a reference explicitly disclosing compound sliding movement has been relied upon. However, it is suggested that the claim be amended to positively recite the structure that is required to perform the recited function. See MPEP 2114 and 2173.05(p), section II. The law of anticipation requires that a distinction be made between the invention described or taught and the invention claimed. It does not require that the reference "teach" what the subject patent teaches. Assuming that a reference is properly "prior art," it is only necessary that the claims under consideration "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or "fully met" by it. *Kalman v. Kimberly-Clark Corp.*, 218 USPQ 789. Claims in a pending application should be given their broadest reasonable interpretation. *In re Pearson*, 181 USPQ 641 (CCPA 1974).

As regards claim 25, (alternatively to part 78) part 86 reads on "latch bolt housing" where plain meaning of "mounted to the pane" is broad enough to include indirect mounting arrangements, for example those other than being – mounted directly on the pane--. By analogy, even though a tire may be mounted to a wheel that is mounted on a hub on an axle mounted to a suspension bolted to a car, it is commonly accepted that 'the tire is mounted to the car'.

As regards claim 31, Pennington '419 teaches "shoulder" – at 60.

Allowable Subject Matter

3. Claims 26, 27, 29, 32, and 42 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

4. Claims 28, 34-41, and 43 are allowed.

Response to Arguments

5. Applicant's arguments have been fully considered but they are not persuasive. Applicant's arguments against the case law cited have little relevance to the merits of the Application. Applicant argues that cited 'adapted to' case law is contrary to other case law but then relies upon case law pertinent to *means plus function* limitations. However, present claim does not contain *means plus function* limitation. See MPEP 2181-2185. Examiners' citation of 'adapted to' case law was intended to inform Applicant of possible unintended broadness in the claims in an effort to expedite Prosecution by affording Applicant the opportunity to amend same during the unlimited stage of Prosecution. See MPEP 2114.

6. Applicant's argument that the term "compound sliding movement" must be interpreted in accordance with the preferred embodiment of the invention since that term has been used in the written description is not persuasive. It is the

examiner's position that simultaneous linear sliding and rotary sliding movement of prior art element anticipates broad limitation of "compound sliding movement". The term "compound sliding movement" is broadly defined at paragraphs 12 and 13 as "between a latched position and an unlatched position". The written description uses the term in reference to the preferred embodiment but does not clearly re-define the term in such a way that it must be interpreted more specifically than its plain meaning would suggest. Examiner recognizes that the written description also describes a particular movement of one embodiment as "compound sliding movement" but one of ordinary skill in the art would not recognize casual use of the term in the written description to be a clear and more limiting legal definition of that term than the more generally art-accepted meaning. See Abstract of USPN 4,735,203 to Ryder for example. The term has art-accepted use consisted with its broadest, reasonable, plain meaning. One of ordinary skill in the art does not have clear reason to interpret the claim as argued by Applicant. Although the specification offers a specific example with respect to 'compound sliding movement', the specification does not clearly redefine and narrow the meaning of the term. It is the examiner's position that more specific interpretation is not consistent with case law and accepted practice. For example, claims in a pending application should be given their broadest reasonable interpretation. In re Pearson, 181 USPQ 641 (CCPA 1974).

7. Inasmuch as the plain meaning of the term is broader than argued by Applicant, and the term has achieved art-accepted meaning broader than argued by Applicant, and the written description uses the term broadly in some instances

and the written description does not clearly (re)define the term in such clear terms and context that one of ordinary skill in the art would recognize the claimed invention necessarily includes further unstated limitations, Applicant's arguments are not persuasive.

If Prosecution is Continued, it is suggested that Applicant simply add further limitations such as -- an angular, serpentine or curvilinear movement—to the claim to ensure that the claimed invention clearly has the scope and meaning that Applicant is now arguing to ensure its full consideration during examination.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary Estremsky whose telephone number is 703 308-0494. The examiner can normally be reached on M-Thur 7:30-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Will can be reached on 703 308-3870. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gary Estremsky
Primary Examiner
Art Unit 3676